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| APPLICATION NO.                                                                           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|-------------------------------------------------------------------------------------------|-------------|----------------------|-------------------------------|------------------|
| 10/628,410                                                                                | 07/29/2003  | Patrick Merheb       | Q76487                        | 6336             |
| 23373                                                                                     | 7590        | 05/17/2005           |                               |                  |
| SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      |                               |                  |
|                                                                                           |             |                      | EXAMINER<br>BALAOING, ARIEL A |                  |
|                                                                                           |             |                      | ART UNIT<br>2683              | PAPER NUMBER     |

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/628,410

Applicant(s)

MERHEB, PATRICK

Examiner

Ariel Balaoing

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 recites the limitation "the IP transport capability" on lines 2-3 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over BATES et al (US 2003/0013456 A1) in view of OLRİK et al (US 2003/0125042 A1).

Regarding claim 1, BATES discloses a method for providing location information from a mobile device to a group of mobile devices (paragraph 26, 27, 32; messages are sent notifying user device of groups presence and location, as well as group message

of notification of user device in area containing location information), said method comprising the steps of generating a message [electronic mail] (paragraph 47, 48), said message comprising presence information related to said mobile device (paragraph 21, 48), wherein said message further comprises an indication related to the location of said mobile device (paragraph 32, 38, 48). Although BATES discloses generation of an electronic mail message and the network having Internet protocol abilities (paragraph 24), BATES does not disclose that the message is a message according to an instant messaging protocol. OLRİK discloses where the location message is a message according to an instant messaging protocol [SMS] (paragraph 6, 8). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the messaging capabilities of BATES to include an instant messaging protocol as SMS messages have similar content as an email message. This is beneficial in that the notification to group members can be made through an established messaging system without the need for an email browser.

Regarding claim 2, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However BATES does not disclose wherein said indication related to the location is obtained by sending a request to a location server belonging to a wireless communication network under the coverage of which said mobile device is located. OLRİK discloses wherein said indication related to the location is obtained by sending a request to a location server belonging to a wireless communication network under the coverage of which said mobile device is located (paragraph 6, 8).

Regarding claim 3, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. BATES further discloses wherein said indication related to the location is obtained upon interrogation of a GPS receiver included in said mobile device (paragraph 34).

Regarding claim 5, BATES discloses a mobile device able to communicate with a group of mobile devices by supporting a client application comprising means for generating a message comprising presence information of said mobile device (paragraph 21, 48), said client application comprising means for encapsulating in said message an indication related to the location of said mobile device [electronic mail] (paragraph 47, 48). However BATES does not disclose where the client application is based on instant message protocol. OLRİK discloses where the client application is based on instant message protocol. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the messaging capabilities of BATES to include an instant messaging application such as SMS messages have similar content as an email message. This is beneficial in that the notification to group members can be made through an established messaging system without the need for an email browser.

Regarding claim 6, BATES discloses a messaging server for providing a group of mobile devices with information on at least one mobile device belonging to said group (paragraph 30, 38), said server comprising an messaging application able to send a message comprising presence information related to said at least one mobile device to said group of mobile devices (paragraph 46, 48), said messaging server further

comprising: means for receiving location information related to said mobile device (paragraph 30, 38); means for including location information related to said mobile device in predefined field of said message destined to said group (paragraph 30, 38). Although BATES discloses generation of an electronic mail message and the network having Internet protocol abilities (paragraph 24), BATES does not disclose that the message is a message according to an instant messaging protocol. OLRİK discloses where the location message is a message according to an instant messaging protocol [SMS] (paragraph 6, 8). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the messaging capabilities of BATES to include an instant messaging protocol as SMS messages have similar content as an email message. This is beneficial in that the notification to group members can be made through an established messaging system without the need for an email browser.

Regarding claim 7, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However BATES does not disclose further comprising means for sending a request to a location server by using the IP transport capability of a wireless communication network. OLRİK discloses further comprising means for sending a request to a location server by using the IP transport capability of a wireless communication network (paragraph 6, 8).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over BATES et al (US 2003/0013456 A1) in view of OLRİK et al (US 2003/0125042 A1) as applied to claim 1 above, and further in view of FITCH et al (US 6,321,092 B1).

Regarding claim 4, see the rejections of the parent claim concerning the subject matter this claim is dependant upon. However, the combination of BATES and OLRİK do not disclose wherein it further comprises the step of: interacting with a Geographic Information System for obtaining logical location information of said mobile device. FITCH discloses interacting with a Geographic Information System for obtaining logical location information of a mobile device (column 12:lines 51-67). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of BATES and OLRİK to include interacting with a Geographic Information System (GIS) for obtaining logical location information of a mobile device as using GIS is another system used to acquire location estimates of mobile devices. This is beneficial in that it allows the ability to correlate coordinate information to mapping information.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IOPPE et al (US 2005/0043037 A1) – System for providing alert-based services to mobile stations

CLARK et al (US 2004/0029577 A1) - Wireless telecommunication system that provides location based messages

FAUCONNIER (US 2002/0183075 A1) – Notification of mobile terminals using geographical coordinates

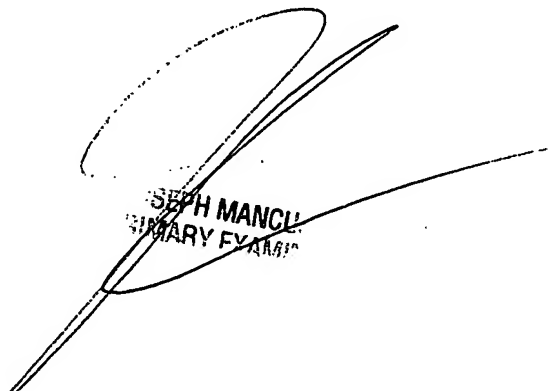
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ariel Balaoing whose telephone number is (571) 272-7317. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ariel Balaoing  
Patent Examiner  
Art Unit 2683

AB



SEPH MANCINI  
MARY EVANS